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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,798	12/20/2001	Christopher Peter Olson	KCC-16,452	9411

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT PAPER NUMBER

3761

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,798	Applicant(s) OLSON ET AL.	
	Examiner Jacqueline F Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/5/04 have been fully considered but they are not persuasive. As to the rejection of claims 1-59 under 35 U.S.C § 103(a) as being unpatentable over Carlucci et al. USPN 6191340, applicant argues that Carlucci does not disclose in the specification an absorbent core that is swellable to a final thickness at least three times greater than its initial thickness. Applicant is directed to Figures 2 and 3 of Carlucci, which generally disclose a flat, planar configuration in Figure 2 (T_1) and a substantially expanded configuration in Figure 3 (T_2), which occurs after liquid insult. While Carlucci does not exactly disclose the amount of expansion, it is obvious from the figures that a significant amount of expansion occurs with liquid insult, which teaches the general condition of the claim limitation. More particularly, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation", *In re Aller* et al, 105 USPQ 233.

In response to applicant's argument that Carlucci does not teach a disposable absorbent article having an overall absorbent capacity of about 300 grams or less, such as a single insult training pant for use as a motivation training aid for toilet training a child, "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of

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making, the intended use must result in a manipulative difference as compared to the prior art". See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this instance, Carlucci recognizes the absorbent capacity of the absorbent core can be varied for the intended use of the article. For example, Carlucci discloses a different absorbent capacity for day time use as compared with those intended for night time use, or a different absorbent capacity depending on the age of the user (col. 5, lines 10-22). It is well within the level of one having ordinary skill in the art would be able to determine which degree of absorbency is appropriate for daytime or nighttime use, and daytime use absorbent articles generally have a lower absorbent capacity as compared to a night time use article where the level of activity is low.

Applicant further argues Carlucci teaches away from the present invention in that it provides an absorbent core that quickly acquires and transmits menses away from the wearer's skin to provide a dry-feeling contact with the body surfaces. Additionally, applicant argues Carlucci provides no motivation to motivate a child during toilet training, whereby the child experiences the consequence of the swelling of the absorbent core upon insult. Carlucci's invention, which begins in a flat, planar configuration in the dry state and swells to a tridimensional shape to better conform to the body, will certainly be felt by a user when the article swells. The fact that Carlucci provides an additional benefit of quickly transmitting fluids cannot be the basis for patentability when the differences in the inventions would otherwise be obvious. If applicant looks to the swelling of the absorbent as motivation for toilet training, then

Carlucci, which also swells substantially meets those conditions, whether or not it is intended to be used in that manner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlucci et al. USPN 6191340.

As to claims 1 and 16-18, Carlucci discloses a disposable absorbent article comprising: an outer cover 26; a body side liner 24 at least partially bonded to the outer cover; and a

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swellable absorbent core 28 positioned between the outer cover and the body side liner having an initial thickness (t_i), the absorbent core swellable to a final thickness (t_f), $t_f \geq 3t_i$. (see Figures 2 and 3, which generally disclose a flat, planar configuration in Figure 2 (T_1) and a substantially expanded configuration in Figure 3 (T_2), which occurs after liquid insult). It is obvious from the figures that a significant amount of expansion occurs with liquid insult, which teaches the general conditions of the claim limitation. More particularly, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation", *In re Aller* et al, 105 USPQ 233.

Carlucci does not specifically disclose an overall absorbent capacity of about 300 g or less. However, Carlucci recognizes the absorbent capacity of the absorbent core can be varied for the intended use of the article. For example, Carlucci discloses a different absorbent capacity for day time use as compared with those intended for night time use, or a different absorbent capacity depending on the age of the user (col. 5, lines 10-22). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of absorbent capacity for a particular application.

As to claim 2, Carlucci discloses an increase in volume, which includes height or thickness of from 2 to 20 times its original volume (col. 13, lines 18-24).

As to claims 3-9, Carlucci discloses a thickness in the range of .5mm to 5mm (col. 12, lines 27-33), which includes the claimed amounts. The disposable absorbent article of claim 1 wherein the initial thickness is less than about 2.0 mm.

As to claims 10 and 11 Carlucci discloses the absorbent core has a width of at least about 25 mm, and at least about 50 mm (col. 13, lines 6-15)

As to claims 12, 14, and 15, Carlucci does not disclose the absorbent core has the claimed lengths and widths. Carlucci does disclose various used for the absorbent such as a diaper, which would inherently have a larger length and width as compared to a sanitary napkin for which Carlucci discloses dimensions. Additionally, with respect to the limitations of the length and width, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the length and width for a particular application.

As to claim 13, Carlucci discloses the absorbent core has a length of about 25 mm to about 700 mm (col. 13, lines 6-15).

As to claim 19, Carlucci discloses the absorbent core comprises a high swelling absorbent material (col. 11, line 64 through col. 12, line 11).

As to claim 20, Carlucci discloses the absorbent article further comprising a surge layer placed over the absorbent core (col. 15, lines 42-46).

As to claims 21 and 38-40, Carlucci discloses an absorbent chassis having an outer cover 26; a body side liner 24, which is connected to the outer cover in a superposed relation; an absorbent core 28 located between the outer cover and the bodyside liner, the absorbent core swellable to a final wet thickness at least about three times greater than an initial dry thickness of the absorbent core (col. 13, lines 19-24 ; Figures 2 and 3). Carlucci does not specifically disclose the absorbent core having a total absorbent capacity not greater than about three times an anticipated insult volume. Applicant discloses in the specification, page 23 lines 11-19, a total absorbent capacity not greater than about three times an anticipated insult volume, an article that accommodates an insult having a volume of about 30 grams (g) to about 100 g, desirably about 60 g to about 80 g. Based on applicant's disclosure, the examiner interprets the above mentioned portion of the claim as being limited to an absorbent article with an absorbent capacity of about 300 grams or less. Although Carlucci does

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not disclose a specific absorbent capacity, Carlucci recognizes the absorbent capacity of the absorbent core can be varied for the intended use of the article. For example, Carlucci discloses a different absorbent capacity for day time use as compared with those intended for night time use, or a different absorbent capacity depending on the age of the user (col. 5, lines 10-22). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of absorbent capacity for a particular application.

As to claims 22 and 28, Carlucci discloses an increase in volume, which includes height or thickness of from 2 to 20 times its original volume (col. 13, lines 18-24).

As to claims 23-27 and 29-31, Carlucci discloses a thickness in the range of .5mm to 5mm (col. 12, lines 27-33), which includes the claimed amounts. The disposable absorbent article of claim 1 wherein the initial thickness is less than about 2.0 mm.

As to claims 32 and 33 Carlucci discloses the absorbent core has a width of at least about 25 mm, and at least about 50 mm (col. 13, lines 6-15)

As to claims 34, 36, and 37, Carlucci does not disclose the absorbent core has the claimed lengths and widths. Carlucci does disclose various used for the absorbent such as a diaper, which would inherently have a larger length and width as compared to

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a sanitary napkin for which Carlucci discloses dimensions. Additionally, with respect to the limitations of the length and width, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the length and width for a particular application.

As to claim 35, Carlucci discloses the absorbent core has a length of about 25 mm to about 700 mm (col. 13, lines 6-15).

As to claim 41, Carlucci discloses the absorbent core comprises a high swelling absorbent material (col. 11, line 64 through col. 12, line 11).

As to claims 42-45, the limitations of training pants, diaper, and incontinence garment are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). If the prior

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art structure is capable of performing the intended use, then it meets the claim limitations. However, Carlucci does teach various uses of the absorbent article (col. 1, lines 5-12)

As to claims 46, 57, and 58, Carlucci discloses a disposable absorbent article comprising: an outer cover 26; a body side liner 24 at least partially bonded to the outer cover; and a swellable absorbent core 28 positioned between the outer cover and the body side liner having an initial thickness (t_i), the absorbent core swellable to a final thickness (t_f), whereby a void area 51 is formed in the swellable absorbent core $t_f \geq 3t_i$, (col. 13, lines 55-60; Figures 2 and 3). Carlucci does not specifically disclose an overall absorbent capacity of about 300 g or less. However, Carlucci recognizes the absorbent capacity of the absorbent core can be varied for the intended use of the article. For example, Carlucci discloses a different absorbent capacity for day time use as compared with those intended for night time use, or a different absorbent capacity depending on the age of the user (col. 5, lines 10-22). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of absorbent capacity for a particular application.

As to claim 47, Carlucci discloses an increase in volume, which includes height or thickness of from 2 to 20 times its original volume (col. 13, lines 18-24).

As to claims 48-54, Carlucci discloses a thickness in the range of .5mm to 5mm (col. 12, lines 27-33), which includes the claimed amounts. The disposable absorbent article of claim 1 wherein the initial thickness is less than about 2.0 mm.

As to claim 55, Carlucci does not disclose the absorbent core has the claimed lengths and widths. Carlucci does disclose various used for the absorbent such as a diaper, which would inherently have a larger length and width as compared to a sanitary napkin for which Carlucci discloses dimensions. Additionally, with respect to the limitations of the length and width, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the length and width for a particular application.

As to claim 56, Carlucci discloses the absorbent core has a length of about 100 mm to about 400 mm (col. 13, lines 9-15).

As to claim 59, Carlucci discloses the absorbent core comprises a high swelling absorbent material (col. 11, line 64 through col. 12, line 11).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

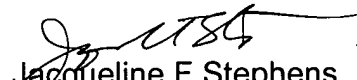
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Examiner
Art Unit 3761

December 21, 2004